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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/564,985	01/18/2006	Nobuhiko Oohara	0092/020001	7191

7590 12/28/2007  
Randolph A Smith  
Smith Patent Office  
1901 Pennsylvania Ave NW  
Suite 901  
Washington, DC 20006-3433

EXAMINER
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NOLAN, JASON MICHAEL

ART UNIT	PAPER NUMBER
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1626

MAIL DATE	DELIVERY MODE
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12/28/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/564,985

**Applicant(s)**

OOHARA ET AL.

**Examiner**

Jason M. Nolan, Ph.D.

**Art Unit**

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>01/18/2006</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This Office Action is responsive to the Transmittal of New Application, filed **01/18/2006**. Claim 1 is currently pending in the instant application.

#### ***Information Disclosure Statement***

Applicants' information disclosure statement (IDS), filed on **01/18/2006** has been considered. Please refer to Applicants' copy of the 1449 submitted herein.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**Claim 1** is rejected under 35 U.S.C. 103(a) as being unpatentable over Zhang *et al.* (US Patent **7,169,953** 01/30/2007, priority to 11/09/2001) in view of Ohashi *et al.* (*Heterocycles* **2000**, 52(2), 905-910).

***Determination of the scope and content of the prior art (MPEP § 2141.01)***

The '953 Patent teaches the transformations of formulae (3) to (4) to (5), wherein **R** = *t*-Bu, **n** = 2, **X** = S. Shown in columns 24 and 25 of the '953 Patent is said transformation. Pointed out in column 24, lines 39-44, the **R** group can be a linear, branched, or cyclic alkyl group. Further teachings in the patent include the reaction of a primary phosphine (RPH<sub>2</sub>) with a base and a cyclic alkylaryl group having a sulfate moiety acting as a dual leaving group, (see column 23, lines 51-64).

. The publication of Ohashi *et al.* teaches the transformation of formula (1) to (3) using formula (2).

***Ascertainment of the difference between the prior art and the claims (MPEP § 2141.02)***

The difference between the '953 Patent and the instant application is the '953 Patent utilizes different synthetic protocols to make formula (3); specifically, using the PC<sub>3</sub> transformation shown in column 24, line 55.

***Finding of prima facie obviousness--rational and motivation (MPEP § 2142-2413)***

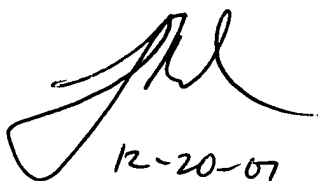
**Claim 1** comprises a process for producing a phosphorus heterocyclic dimer that comprises chemistry known to one of ordinary skill in the art. The difference between the instant claim and that of the prior art does not make the invention as a whole patentably distinct from what is in the public domain. The invention lacks a contribution over what is known in the prior art.

***Claim Objections***

**Claim 1** is objected to because of the following informalities: The preamble of the claim should read, "A process for producing a phosphorus heterocyclic dimer *according to formula 5...*" to clarify the scope of invention. Appropriate correction is required.

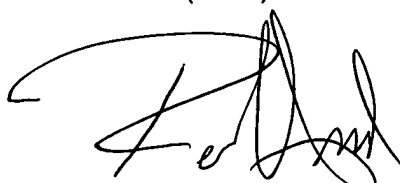
***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jason M. Nolan, Ph.D.** whose telephone number is **(571) 272-4356** and electronic mail is **Jason.Nolan@uspto.gov**. The examiner can normally be reached on Mon - Fri (9:00 - 5:30PM). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Joseph M<sup>c</sup>Kane** can be reached on **(571) 272-0699**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



12-20-07

Jason M. Nolan  
Patent Examiner  
Art Unit 1626  
(571) 272-4356



REBECCA ANDERSON  
PRIMARY EXAMINER

Patent Examiner  
Art Unit 1626